REMARKS

Applicants appreciate the thorough review of the present application as reflected in the Official Action mailed March 30, 2004. Applicants have cancelled Claim 1 and amended Claim 2 to write Claim 2 in independent form. Applicants have amended Claims 10, 12 and 14 to depend from Claim 2. Applicants have amended Claim 15 to incorporate the recitations of Claim 17 and have cancelled Claim 17. Claims 18 has been amended to depend from Claim 15. Claims 26, 34 and 37 have also been written in independent form. Claim 35 has been cancelled and Claim 36 has been amended to depend from Claim 37. Claims 39 and 41 have been amended to incorporate means-plus-function recitations and computer program code recitations, respectively, corresponding to the method recitations of Claim 17. Claims 40 and 42 have been amended to incorporate means-plus-function recitations and computer program code recitations, respectively, corresponding to the method recitations of Claim 37. Claim 43 has been cancelled.

The IDS

Applicants wish to bring to the attention of the Examiner an Information Disclosure Statement that is being filed concurrently herewith. Applicants request that the Examiner consider the materials cited in the IDS and return an initial copy of the PTO-1449 form with any subsequent communication.

The Section 112 Rejection

Claim 14 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite for lack of antecedent basis. Applicants have amended Claim 14 to depend from Claim 2 and, therefore, submit that each of the recitations of Claim 14 have proper antecedent basis. Accordingly, Applicants request withdrawal of the rejection of Claim 14.

The Obviousness Rejections
Claims 1 and 10-11

Claims 1 and 10-11 stand rejected under 35 U.S.C. § 103 as obvious in light of United States Patent No. 5,337,357 to Chou *et al.* (hereinafter "Chou"). Applicants

have cancelled Claim 1 and Claims 10 and 11 now depend from Claim 2.

Accordingly, Applicants submit that the rejection based on Chou has been overcome.

Claims 2-4, 7, 12-13, 15-17, 19-24, 26-30 and 35-43

Claims 2-4, 7, 12-13, 15-17, 19-24, 26-30 and 35-43 stand rejected under 35 U.S.C. § 103 as obvious in light of the combination of Chou and United States Patent No. 5,416,840 to Cane *et al.* (hereinafter "Cane"). Applicants will first address the rejections of the independent claims based on Chou and Cane and then address the rejections of the dependent claims.

Claims 2, 15, 39 and 41

Claim 2 has been written in independent form. Claim 17 has been written in independent form as amended Claim 15. Claims 39 and 41 have been amended to incorporate recitations analogous to those of Claim 17. In rejecting Claims 2 and 17, the Official Action acknowledges that Chou does not disclose generating a second key from the first key value and first secret key value, encrypting the decrypted portion of the software with the second key value and storing the portion of the software encrypted with the second key value. Official Action, p. 5. The Official Action, however, relies on Cane, col. 5, lines 8-19 and col. 6, line 64 to col. 7, line 8 as teaching encrypting the decrypted portion of the software. Official Action, p. 5. However, the Official Action acknowledges that none of the cited references disclose the generation of a second key and encrypting the decrypted portion with the second key. Official Action, pp. 5-6.

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See* M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine

must be **clear and particular**, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be **particular** evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as recently stated by the Federal Circuit with regard to the selection and combination of references:

> This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

In re Sang Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002).

As acknowledged by the Official Action, none of the cited references disclose the generation of a second key based on the first key and the first secret value. Official Action, pp. 5-6. In particular, the cited portion of Cane at col. 5 merely states that the software may be further encrypted to prevent subsequent impermissible copying. The cited portion of Cane at cols. 6 and 7 merely describes encrypting an authorization code. There is no discussion in the cited portions of Cane or Chou that discloses or suggests generating a second key and encrypting the decrypted portion with the generated second key.

The Official Action appears to acknowledge that neither Cane nor Chou disclose such recitations, but states that "[i]t would have been obvious to one of ordinary skill in the art at the time of the applicants invention to modify the combination of Chou et al and Cane et al to further encrypt the decrypted portion of the software with a second key value because the applicant has not explicitly stated the purpose of such an encryption other than preventing future installations and the

method of encrypting the portion of the software in the combination of Chou et al and Cane et al is just as efficient." Official Action, pp. 5-6. Such a motivation to combine is improper as it fails to provide a motivation to combine the references **to result in the recitations of the claims**. It appears that the Official Action is arguing that because the present application does not appear to have stated an advantage over a combination of Chou and Cane that does not result in the recitations of the claims, that it would be obvious to modify this combination of references because using the combination of Chou and Cane would be just as efficient as doing what is in the claims. Applicants submit such an argument cannot provide the proper basis for an obviousness rejection.

Even if the argument in the Official Action is somehow interpreted to be stating that the combination of Chou and Cane would result in the recitations of the claims, which Applicants submit it would not, the logic of the Official Action is flawed. If the combination of Chou and Cane achieves the same result as performing the recitations of the claims and is just as efficient, then one of skill in the art would have no motivation to modify the combination of Chou and Cane to result in the recitations of the claims. Thus, if the logic of the Official Action is used, the Official Action establishes that there is no motivation to modify Chou and/or Cane.

Furthermore, Applicants submit that, even if Chou and Cane were somehow combined, that the combination would not result in the recitations of the claims. For example, Chou encrypts the software with a key and the obtains a first key value from a user. Chou, Figure. Based on the key used to encrypt the software, Chou determines a second key that when combined with the first key results in the key used to encrypt the software. Chou, Figure. Thus, if the key used to encrypt the software is changed, the system of Chou would be unable to generate the second key value to provide to a user as the processing center would not know what key was used to encrypt the software. The way Chou prevents further subsequent installations on different computers is through a unique random factor, such as the use of a time dependent unique factor. See Chou, col. 2, line 57 to col. 3, line 13. Cane provides no further insight as the cited portions of Cane only mention encrypting the software may prevent subsequent installs. Thus, neither Chou nor Cane suggest how to generate a new key or that the decrypted portion of the program be encrypted using a

new, different key. As such, even if combined, Applicants submit that Chou and Cane would not result in the recitations of Claims 2 and amended Claims 15, 39 and 41.

In light of the above discussion, Applicants submit that Claims 2, 15, 39 and 41 and the claims that depend from them are patentable over the cited references. Accordingly, allowance of these claims is respectfully requested.

Claim 26

Claim 26 has been written in independent form and recites, in part:

> generating the first key value based on the first and second secret values at the network server; and
> associating the first key value with the identification of the copy of the software as an updated second secret value to be provided in response to a subsequent request for the second secret value.

As discussed above, neither Chou nor Cane disclose or suggest generating a new key value or associating the new key value as a secret value to be provided in response to a subsequent request as neither reference discloses or suggests encrypting with different values.

The Official Action states that Chou discloses generating a different secret value based on randomness. Official Action, p. 12. However, Chou does not describe generating the new value based on the first and second secret values or associating the key value with the software to be provided in response to a subsequent request for a second secret value. In fact, if a different secret value is generated in the Chou system the installation will fail. Accordingly, Applicants submit that Claim 26 is patentable over the cited references for at least these additional reasons. Applicants also submit that the claims that depend from Claim 26 are patentable at least as depending from a patentable base claim.

Claims 37, 40 and 42

Claim 37 has been written in independent form and recites, in part:

> generating a first key value from the first and second secret values associated with the copy of the software; and
> associating the first key value with the software identification of the copy of the software as an updated first secret value.

Thus, Applicants submit that Claim 37 is patentable over the cited references for reasons analogous to those discussed above with reference to Claim 26. Applicants also submit that the claims that depend from Claim 37 are patentable at least as depending from a patentable base claim. Claims 40 and 42 have been amended to incorporate means-plus-function recitations and computer program code recitations, respectively, corresponding to the method recitations of Claim 37 and, therefore, are patentable for analogous reasons.

The Dependent Claims

While each of the dependent claims are patentable as depending from a patentable base claim, Applicants submit that certain of the dependent claims are separately patentable over the cited references. For example, Claim 27 further recites:

> copying the first encrypted portion of the software from a read only media to a writeable storage media;
> generating a second key value from the first key value and the first secret value;
> encrypting the decrypted first encrypted portion of the software with the second key value; and
> storing the first encrypted portion of the software encrypted with the second key value on the writeable storage media.

Applicants submit that these operations are neither disclosed or suggested by Chou and/or Cane.

Claims 5-6, 25 and 31-33

Claims 5-6, 25 and 31-33 stand rejected under 35 U.S.C. § 103 based on Chou, Cane and United States Patent No. 5,666,411 to Larsson et al. (hereinafter "Larsson"). Applicants submit that these claims are patentable at least as depending from a patentable base claim. Applicants also submit that the Official Action has failed to establish a prima facie case of obviousness with respect to these claims. In particular, the Official Action fails to provide a proper motivation to combine that does not use hindsight and misapply the legal standards for obviousness. For example, the burden is not on Applicants to explicitly state a particular reason for using the recitations of the claims as asserted in the Official Action. See Official Action, p. 18. The burden is on the Patent Examiner to provide a motivation for

combination of references that result in the recitations of the claims. Accordingly, Applicants submit that these claims are patentable over the cited references for at least these additional reasons.

Claims 8, 9, 18 and 34

Claims 8, 9, 18 and 34 stand rejected under 35 U.S.C. § 103 based on Chou, Cane and United States Patent No. 5,661,411 to McCarty (hereinafter "McCarty"). Claims 8, 9 and 18 are dependent claims and, therefore, are patentable at least as depending from a patentable base claim. Claim 34 has been amended to write Claim 34 in independent form. Accordingly, Claim 34 recites, in part:

> encrypting the first encrypted portion of the software as a plurality of encrypted blocks;
> wherein the step of decrypting the first encrypted portion of the software comprises decrypting an encrypted block of the plurality of encrypted blocks with the first key value;
> wherein the step of encrypting the decrypted first encrypted portion of the software comprises encrypting the decrypted block with the second key value;
> wherein the step of storing the first encrypted portion of the software encrypted with the second key value comprises storing the block encrypted with the second key value; and
> wherein the block of the plurality of encrypted blocks is decrypted, encrypted and stored before a next block of the plurality of blocks is decrypted, encrypted and stored.

Applicants submit that these recitations are neither disclosed nor suggested by Chou, Cane and/or McCarty. In particular, Applicants submit that the recitations of encrypting with the second key value are neither disclosed nor suggested at least for reasons analogous to those discussed above with reference to Claims 2 and 15.

Conclusion

In light of the above discussion, Applicants submit that the present application is in condition for allowance, which action is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

It is not believed that an extension of time and/or additional fee(s)-including fees for net addition of claims-are required, beyond those that may otherwise be

provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 09-0461.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on June 29, 2004.

Traci A. Brown
Date of Signature: June 29, 2004